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IN THE

Supreme Court of the United States

October Term, 1951
No. 774

OXNARD CANNERS, INC., a corporation, and JAMES L. SMITH,

Petitioners,

against

THOMAS W. BRADLEY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

C. P. GOEPEL,
Attorney for Petitioner.

J. E. TRABUCCO,
Counsel.

SUPREME PRINTING CO., INC., 41 MURRAY STREET, N. Y., BARCLAY 7-0349

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No.

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Petitioners,

against

THOMAS W. BRADLEY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Your petitioners respectfully pray that a writ of certiorari issue to the Court of Appeals for the Ninth Circuit to review the judgment of that Court, entered February 18, 1952 (R. p. 267), holding valid Letters Patent 2,477,168, granted July 26, 1949, to T. H. Bradley for a "Fish Eviscerating Apparatus", for removing the entrails from Monterey sardines, and infringed by Petitioners' machines constructed under and in accordance with U. S. Letters Patent No. 2,483,470, granted October 4, 1949, to Lockwood and Smith, for "A Fish Cleaning Apparatus", of which Petitioner Smith is a co-patentee.

Jurisdiction

The jurisdiction of the Court is invoked under 28 U. S. C. Section 1254(1). The judgment of the United States Court of Appeals for the Ninth Circuit was entered February

18, 1952, and this petition has been filed within ninety days thereof—mandate having been stayed.

Opinion Below

The opinion of the Court of Appeals is printed on R. pp. 270-280. It is reported in 194 F. 2d 655 (advance pamphlet No. 4 of April 14, 1952).

Statement of the Case

The usual patent infringement complaint was filed by Respondent, as patentee of U. S. Letters Patent No. 2,477,168 of July 26, 1949, for a "Fish Eviscerating Apparatus", charging that the machines sold to Petitioner Oxnard Canners, Inc. infringed said patent. Petitioners' machines were constructed under and in accordance with U. S. Letters Patent No. 2,483,470, granted October 4, 1949, for "A Fish Cleaning Apparatus".

The applications for the respective patents were pending without conflict in the Patent Office at the same time for more than three years. Only a limited number of Respondent's machines were used (R. p. 67). About 300 machines of the Lockwood and Smith patent construction (R. p. 208) were commercially produced and distributed (Opinion R. p. 274).

Petitioner Smith having intervened, an amended complaint was filed June 29, 1950 (R. pp. 3-6). The answers herein (R. pp. 6-9 and 10-12) denied validity of Respondent's patent, alleging non-invention and particularly that Respondent's claim was an aggregation of elements rather than a patentable combination (R. p. 9), and also denied that the said patent in suit was infringed by Petitioners' machines, constructed under Petitioner Smith's patent as stated in the counterclaim (R. pp. 12-13). The counterclaim (R. pp. 12-13) and the answer thereto (R. pp. 14-15) have no further relevance herein.

The action was tried before a jury, but there were no disputed issues of fact as to the structure of the patent in suit, the prior art patents, or the structure of Petitioners' machine (R. pp. 46-236). The jury, which rendered its verdict for the Respondent-Plaintiff, found the patent in suit valid and infringed by Petitioners-Defendants as to Claim 1 and assessed damages (R. p. 16); and judgment on the verdict was entered (R. pp. 17-19). Petitioners then moved for judgment notwithstanding the verdict, or in the alternative for a new trial (R. pp. 19-31). Respondent filed in opposition thereto a memorandum in which it was urged that the Bradley patent (R. pp. 32-39) "produces a new, a beneficial result in a more efficient, economical and facile manner" (R. p. 34). The trial judge denied the said motion, stating that on such motion—

> "The only question that really presents itself to the Court * * * is the question of invalidity of the plaintiff's patent, and where it does, if at all, involve any question of law, the judge does not have to decide the law" (R. p. 255).

and further,

> "And I say this, not intending to be critical at all: I couldn't find myself in a state of mind to believe that there was pressed particularly forcefully as a defense to the action, because it did appear that there was a contribution by the plaintiff from the claims of his patent of a combination nature that did give a plausible ground for the issuance of the patent—and I think that could be seen by the jury just as well as it could be by the court—and that there is not presented now a legal question which has to be determined by the court based upon evidence that was not in conflict with respect to those prior art patents" (R. p. 256).

and further,

> "Inasmuch as I feel that there was a factual question presented in both issues, under the circum-

> stances of the particular case I think that there is no compelling reason why the court should change the verdict of this jury on the matters that were submitted to the jury for decision. I will therefore enter an order denying the motion" (R. p. 257).

A similar absence of the law applicable to the facts pervades his entire charge to the jury (R. pp. 236-250, particularly pp. 242, 244).

An appeal from the said judgment was filed (R. p. 40), on a statement of the points upon appeal (R. pp. 259-263). The Court of Appeals affirmed, with an opinion substantially following the trial judge's reasoning that the questions of validity and infringement were factual issues, and also applying on the question of the validity of the patent in suit an erroneous concept of what constitutes a true and patentable combination, and failing to scrutinize the assumed combination to determine whether invention was actually present as a matter of law, and likewise treating the infringement question as one of fact instead of law, in the absence of disputed facts (R. pp. 269-280).

Questions Presented

1. Where the basic facts are undisputed, the questions whether the patent is valid and whether the accused structure infringes such patent are questions of law within the judicial function of the judge.

2. The principle in the law of combination patents, long considered settled, that a legal or true combination of old parts can only be sustained if a new and useful result, never before known, has been obtained, by the joint action of the elements acting under a new law of operation should not be eroded by substituting for such a novel result, an old result produced in a more facile, efficient or economical way.

3. Once having established that a true combination of old parts has been brought into being, it is still solely a question of law whether that combination is clothed with the attributes of invention.

4. While the ascertainment of the ultimate facts as to the presence of invention and as to the existence of infringement necessarily involves a factual sufficiency, the application to such facts, so ascertained, of the legal concepts of patentable invention and of infringement is at all times, for the Court's determination.

5. A patent claim claiming the entire apparatus, already long known, when all the patentee has is a specific point of alleged novelty therein, is void for overclaiming.[1]

Specifications of Errors

The Court of Appeals erred:

(1) in holding that the grounds for invoking the Esnault Pelterie Rule, 303 U. S. 26, 30 (R. p. 278) are absent in the case at bar, overlooking that there are no crucial facts in dispute, and that the prior art patents, the patent in suit, and Petitioners' patent exemplifying Petitioners' structure are simple and clear on their face;

(2) in relying on the cited authorities (R. p. 280), which departed from the rulings of this Court in *Seymour* v. *Osborne,* 11 Wall (U. S.) 516, 548, 20 L. ed. 33; *Gould* v. *Rees,* 15 Wall (U. S.) 187, 189, 21 L. ed. 39; *Hailes* v. *Van Wormer,* 20 Wall (U. S.) 353, 22 L. ed. 241, 249, in which this Court required that a combination of old elements must produce "a new and useful result", not before known, brought about by the joint action of the elements, and must perform an "additional or different function in the com-

[1] *Seymour* v. *Osborne* (1868) 11 Wall (U. S.) 516, 20 L. ed. 33, 38. *Great A. & P. Co.* v. *Supermarket Equip. Corp.,* 340 U. S. 147, 95 L. ed. 162.

bination than they perform out of it", as was more recently held in *The Great A. & P. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147, 95 L. ed. 142;

(3) in failing to inquire whether an invention exists and in failing to scrutinize the claim in suit to determine whether the "case is wanting in any unusual or surprising consequences from the unification of the elements here concerned". (*The Great A. & P. Tea Co.* v. *Supermarket Equip. Corp, supra);*

(4) in holding that the issues on the elements of the controversy, validity and infringement, are questions of fact, relying on *Faukner* v. *Gibbs* (9 Cir. 1948, Judge Bone), 170 F. 2d 34, and cases cited therein;

(5) in failing to hold as a matter of law that the patentee Bradley "overclaimed", in that he claimed a complete apparatus, long known, instead of a specific combination or improvement, if any [1]; that an aggregate of old elements being unpatentable, the insertion of a specific element, the rotatable disk valve, cannot revive an exhausted combination [2], and that the claim in suit embodying several distinct units of invention [3] is invalid;

(6) in assuming that Petitioners' and Respondent's valves were substantially identical, when applying the transposition rule (R. p. 275), overlooking that Petitioners' valve is a different construction, a new and independent invention, accomplishing by different means different functions and results not possible with the Respondent's vertically rotating disk,[4] and that the respective valves are not interchangeable;

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[1] *Supermarket* case, *supra.*

[2] *Bassick* v. *Hollingshead,* 298 U. S. 415, 80 L. ed. 1251. *Lincoln Engineering Co.* v. *Stewart, Warner Corp.,* 303 U. S. 545, 82 L. ed. 1008.

[3] Robinson on Patents, Vol. 1, Sec. 152, p. 216.

[4] *Brooks et al.* v. *Fiske et al.,* 15 How. 212, 14 L. ed. 665; *Snow* v. *Railway Co.,* 121 U. S. 617, 30 L. ed. 1004; *Union Steam Pump Co.* v. *Battle Creek Steam Pump Co.* (6 Cir. 1900) 104 Fed. 337; *Deister Concentrator Co.* v. *Deister Machine Co.* (7 Cir. 1917) 241 Fed. 379, 384.

(7) in failing to apply the legal concept controlling the infringement element of the controversy as to which there is no legally sufficient evidence in the case, to wit: that an infringement of the respective elements can only exist where substantially the same means, function, and result are obtained, when joined to perform the same cooperative law of the combination;

(8) in holding that the prior art McGrew machine (Patent 2,192,838) is "totally unlike the Bradley (or Smith) machine in mode of operation, construction and result", and in relying on a conjecture for an answer (R. pp. 278, 279), when the McGrew patent was substantially identical with the Bradley patent, save for a rotatable disk valve instead of the fixed plate valve, and in failing to hold that though McGrew may not anticipate, there is no invention in substituting for its fixed plate valve a prior art movable valve, cylindrical (Kurzbin No. 2,326,146), a movable plate (Gray No. 1,628,968), or disk (Abbott No. 1,463,111), between the suction station and the vacuum chamber;

(9) in failing to decide that the claim violated Rev. Statute, Sec. 4888, 35 U. S. C. 33, in that the crucial element of the claim, the "rotatable disk" valve, does not point out the physical characteristics of the disk in relation to its coacting parts, and that it is vertical to the horizontal movement of the fish [1], said claim now requiring construction as to its meaning with its general phrase "rotatable disk valve" limited to its specification meaning;

(10) in holding that the presumption of non-infringement with Bradley by the issuance of Petitioners' Lock-

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[1] *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245, 256; 76 L. ed. 868, 873; *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 368, 82 L. ed. 1402, 1405; *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1, 91 L. ed. 3.

wood and Smith patent No. 2,483,470, was overcome by evidence, in the absence of legally sufficient [1] evidence;

(11) in failing to decide that since Bradley, by disclaiming the same claim in the Patent Office proceedings calling for a valve generally, and obtaining allowance of said claim by the insertion of the specific "rotatable disk valve", was estopped thereby from thereafter neutralizing his disclaimed claim by claiming equivalents, to include the disclaimed subject-matter; [2]

(12) in failing to decide that if the Bradley claim is valid, it was confined to its structure, and that Petitioners' structure was a different one not legally in conflict with Bradley's; [3] and

(13) in relying on general evidence, as quoted in its opinion, not relevant to the point at issue of the specific infringement.

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[1] *Boyd* v. *Janesville Hay Tool Co.* (1895) 158 U. S. 260, 261, 39 L. ed. 973.

[2] *Smith* v. *Magic City Kennel Club,* 282 U. S. 784, 789, 75 L. ed. 707, 712; *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U. S. 211, 85 L. ed. 132; *Shepard* v. *Carrigan,* 116 U. S. 593, 598, 29 L. ed. 723, 724; *Goodyear Dental Vulcanite Co.* v. *Davis,* 102 U. S. 222, 228, 26 L. ed. 149, 151.

[3] *Exhibit Supply Co.* v. *Ace Patents Corp.,* 315 U. S. 126, 86 L. ed. 736; and *Keystone Bridge Company* v. *Phoenix Iron Co.,* 95 U. S. 274, 24 L. ed. 344. *Kokomo Fence Mach. Co.* v. *Kitselman,* 189 U. S. 8, 23, 47 L. ed. 689, 696.

Reasons for Granting the Writ

Probable absence of conflict in other circuits.

In Monterey, California, an industry developed to catch and can the Monterey sardines, and it was necessary to provide a machine to remove the entrails of the fish before canning. All of the patentees of record reside in the Ninth Circuit. As only a limited number of Respondent's machines were used, tribute under the patent in suit falls upon Petitioners' successful commercial machines, used only in the Ninth Circuit and in foreign countries. Any subsequent injunction will prevent further use and distribution of Petitioners' successful machines. This concentration of improvers and canners and the locality of the canning of such Monterey sardines in Cannery Row in Monterey are not likely to bring about a contest of the patent in suit in any other circuit; and the entire industry will be subjected to the alleged monopoly of the Bradley patent.[1] The interest of the public is always involved in a patent case, and the public is to be protected from an unjust monopoly.[2]

Departure from the usual practice in patent cases.

Were the Bradley patent a real invention and Petitioners' machine a piratical or Chinese copy thereof, the foregoing situation would be a natural consequence of a wrongful act. But the Bradley patent is merely a catalogu-

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[1] In *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 128, 86 L. ed. 736, 740; and *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 47, 83 L. ed. 34, 36, 304 U. S. 587, 82 L. ed. 1548, 58 S. Ct. 1052, 1053, petitions were granted where a conflict was not probable.

[2] *Veaux* v. *Southern Oregon Sales Inc.* (1940), 33 F. S. 605, at 610, affd. (9 Cir. 1941), 123 F. 2d, 455.

ing of the corresponding old elements of the prior art. It had been allowed by the examiner of the Patent Office after having been rejected as a catalogue of old elements, by the substitution for the words "valve means", in the rejected claim, of the very specific "rotatable disk" valve—"a shadow of a shade of an idea". The Bradley patent machine used this old aggregation of parts with a vertical rotatable disk valve having a horizontal axis. It was deficient in operation, preventing a commercial development of such a machine by Petitioners, prior to the issuance of the Bradley patent. Petitioner Smith, with his associate Lockwood, then conceived an entirely new valve in the form of a turret or cylinder with a vertical axis, with ports registering in their entirety with the exposed viscera while these ports moved in a horizontal plane coincident with the horizontal plane in which the decapitated fish were moving.

This radical departure was recognized by the Patent Office as a separate and independent invention. The claims were confined to the thing invented instead of claiming the entire old machine as an entirety, as Respondent's patent did. No conflict as to identity with Bradley ever arose during the three years these applications were co-pending. The presumption of non-infringement,[1] accompanying the issuance of Petitioner Smith's patent, was at no time rebutted by any legally sufficient evidence. In fact, the generality of the evidence, quoted in the opinion below, cannot possibly meet the legally required burden of proof of infringement—that Petitioners' valve is the same in law as that of Respondent's, as to which specific issue the record is silent of legally sufficient proof. The case at bar closely resembles *Phillips* v. *Page,* 65 U. S. 24, 16 L. ed. 639, 641.

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[1] *Boyd* v. *Janesville Hay Tool Co.,* 158 U. S. 260, 261, 39 L. ed. 973.

The jury determined the patent in suit valid and infringed, upon an array of evidentiary facts without any proper teaching by the court of the law applicable thereto. On validity, the jury was told that the patent in suit had a presumption of validity[1] (R. p. 241), and that invention is something different and apart and more than that which may be accomplished by the "ordinary mechanic skilled in his art" (not the art of this patent) (R. p. 242). On infringement, the jury was told that if "defendant has constructed a device which appropriated for the defendant the essential disclosures of the plaintiff's patent" (R. p. 243) (omitting the claim), and that if the defendant has appropriated all the elements of the claim (R. p. 244), then infringement follows.[2] Also it was charged, "we can put this in another way by saying: Does this device which the defendant has made accomplish substantially the same results by substantially the same means as that which is disclosed in the claim * * *" (R. p. 244). No exceptions were taken to the charge.

But the law is well stated and to the contrary in *Eames* v. *Godfrey*, 1 Wall. (68 U. S.) 78, 80, 17 L. ed. 547, 548, 78, 80, 17 L. ed. 547, 548, and *Ruth* v. *Climax Molybdenum Co.* (10 Cir. 1938) 93 F. 2d 699. This Court can always

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[1] Presumption of validity has little value, *Cusano* v. *Kotler* (3 Cir. 1947), 159 F. 2d, 159, 160, and no value as against a patent not found by the Patent Office examiner.

[2] Infringement is not proved merely by reading a claim upon an accused device, *McRoskey* v. *Braun Mattress Co.* (9 Cir. 1939), 107 F. 2d, 143, 146.

examine the record [1] to determine whether there is any substantial evidence fairly tending to support the verdict. The judgment on verdict was then entered without the court having considered the fundamental question of the law applicable thereto—an essential requirement in the sui generis cases to which a patent suit belongs, whatever may be the situation with a run-of-the-mill case. The Court of Appeals likewise omitted the law applicable in determining the invention question, and also the infringement question.

This departure from recognized procedures would justify a review of the case at bar to prevent confusion in subsequent litigation.

The Court of Appeals decision is in conflict, in principle, with the decisions of this Court.

Judge Pope, in relying on *Faulkner* v. *Gibbs*, *supra*, the opinion of which he also wrote, holding the questions of invention and infringement questions of fact, is in direct conflict with the holding of Mr. Justice Douglas, in his concurring opinion, in the *Supermarket* case *supra*—that the question of the validity of a patent is a question of law (citing *Mahn* v. *Harwood* (1884) 112 U. S. 354, 358, 28 L. ed. 665, 667). It is also contrary to that part of *Sanitary Refrigerator Co.* v. *Winters* (1929) 280 U. S. 30, 36, 74 L. ed. 147, 152, which stated "* * * the question of infringement resolves itself in each case into one of law * * *," and contrary to *Singer Mfg. Co.* v. *Cramer* (1904) 192 U. S. 265, 275, 48 L. ed. 437, 443, in which invention presented a question of law.

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[1] *Mortensen* v. *U. S.* (1944), 322 U. S. 369, 374, 88 L. ed. 1331, 1335; *Abrams* v. *U. S.* (1919), 250 U. S. 616, 619, 63 L. ed. 1173, 1176; *Eckenrode* v. *Penn. R. R. Co.* (1948), 335 U. S. 329, 93 L. ed. 41; *Metropolitan R. R. Co.* v. *Moore* (1887), 121 U. S. 558, 30 L. ed. 1022, 1025.

The case at bar, in relying on *Faulkner* v. *Gibbs, supra,* adds to the confusion, and if overruled will be in harmony with the principle set forth in the case of *Sinclair & Carroll Co.* v. *Interchemical Corp.,* 325 U. S. 327, 89 L. ed. 1644, requiring judges to examine into and determine the validity and infringement elements of the controversy.

Conflict in the Ninth Circuit.

The case at bar is in conflict with *Bailey* v. *Sears, Roebuck & Co.* (9 Cir. 1940) 115 F. 2d 904, 906, which held the combination invalid for failure to produce a new function; and in conflict with *Lane-Wells Co.* v. *Johnston Oil Field Service Corp.* (9 Cir. 1950, Judges Driver, Healey and Bone), 181 F. 2d 707, which latter case declined to follow *Faulkner* v. *Gibbs, supra.*

While *Faulkner* v. *Gibbs* was affirmed by this Court (338 U. S. 267), it is quite clear that this Court merely affirmed because it was "not persuaded that the findings are shown to be clearly erroneous". There is nothing in the "Per Curiam" opinion of this Court to indicate that it accepted and approved the alleged legal principles listed in Judge Bone's opinion at page 37 of the *Faulkner* v. *Gibbs* case, in support for which Judge Woodbury's case of *Hanovia Chemical & Mfg. Co.* v. *Buttrick Co.* (1 Cir. 1942), 127 F. 2d 888 was cited in the footnote.

We submit that Judge Woodbury's reasoning holding invention to be a question of law is sound and that in this inter-circuit conflict, *Faulkner* v. *Gibbs, supra,* should fall, and the judgment in this case at bar with it, as being against the weight of authority of other Courts of Appeals.

The point is a nice one in this "age-old problem". In the Journal of Patent Office Society, April 1948, Vol. XXX, No. 4, Mr. Frank Parker Davis in "Patentable Novelty", after analyzing, at page 282, the cases on whether invention is a question of fact or a question of law, could not reach a conclusion. Perhaps the confusion arises from failure to

distinguish between the question of fact as to novelty and utility, and the question of law as to "invention", since a change in kind, a necessary attribute of a patentable invention (Renwick on "Patentable Invention" 1893), instead of degree, is always a question of law. This view is not contrary to the frequently misquoted case of *Thomson Spot Welder Co.* v. *Ford Motor Co.* (1923) 265 U. S. 445, 68 L. ed. 1098, where Mr. Justice Sutherland speaks of "invention" as an invention and not as a patentable invention. True, as stated by him, "the question whether an improvement requires mechanical skill or the exercise of the faculty of invention" is one of fact, since it is necessary to first determine that a gap exists between the improvement and the nearest prior art. It still remains to determine whether that gap was bridged by a process of logical reasoning of a mechanic, or by the creative imagination of a kind amounting to a "patentable" invention. That is a question of law only. For the purpose of the *Spot Welder* case, there was no need for Mr. Justice Sutherland to extend his reasoning further than he did.

This Court may be surprised that this question is called by some of the judges, "age-old". Perhaps Mr. Walker started this confusion. Walker, in his first edition (1882), states that invention is a question of fact and cites two cases which do not sustain that statement. But that statement, with a geometric accumulation of cases, was followed in the subsequent six editions. As Walker on "Patents" has been the ready reference book throughout all these years in the practice of patent law, undoubtedly it had a great influence on the judges, overlooking, as did Mr. Walker and his revisers, that this Court has spoken repeatedly to the contrary.[1]

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[1] *Heald* v. *Rice*, 104 U. S. 737, 749, 26 L. ed. 910, 914; *Mahn* v. *Harwood* (1884), 112 U. S. 354, 358, 28 L. ed. 665, 667; *Singer Mfg. Co.* v. *Cramer*, 192 U. S. 265, 275, 48 L. ed. 437, 443. *Fond du Lac County* v. *May*, 137 U. S. 395, 34 L. ed. 714.

Conflict has arisen between the First and Seventh Circuits as to invention being a question of fact or law.

An interesting situation presents itself between the holding of Judge Mahoney, who said, "until advised to the contrary by the Supreme Court, we shall so regard it", referring to a question of fact (*Lincoln Stores* v. *Nashua Mfg. Co.* (1 Cir., 1946 157 F. 2d 154, 163). Judge Woodbury, in his dissenting opinion, said (p. 164): "I am willing to agree with my associates in regarding the question of invention as one of fact until advised to the contrary by the Supreme Court * * *".

Judge Woodbury, speaking also of the confusion in the law with respect to the nature of patentable invention, in *Bellavance* v. *Morrow Co., Inc.,* (1 Cir. 1944), 141 F. 2d 378, 379, on behalf of the entire bench, said: "The most that circuit courts of appeal and district courts can do is * * * apply to the best of our ability the standard as we think the Supreme Court would apply it if a conflict between circuits should arise and the certiorari should for that reason be granted. As the law now stands this is the only way we and the district courts can aid in obtaining a uniform application of the patent law".

A collection of pertinent cases is contained in Judge Fahy's opinion in *Standard Oil Development Co.* v. *Marzall,* (C. A. D. C. 1950), 181 F. 2d 280. At page 283, he particularly refers to the nature of a finding: "The nature of a finding of non-patentability because of the absence of invention places it in a special though not unique category within the general category of fact finding * * * ", and in his concluding paragraph on page 284, states: "All facts are not of the same general character. A court need not ignore entirely the difference between an objective fact and a subjective opinion though each is termed a factual matter * * *".

Having these views in mind, an analysis of *Goodyear Tire & Rubber Co. Inc.* v. *Ray-O-Vac Co.,* (1944), 321 U. S.

275, 64 S. Ct. 593, 88 L. ed. 721, shows it did not hold invention to be a question of fact, as Judge Mahoney, in *Lincoln Stores* v. *Nashua Mfg. Co. supra,* believed it to be. All that Mr. Justice Roberts did, we submit, was to find the fact of extensive sales as an attribute of invention, from which he concluded that invention existed, and his affirmance of concurring findings of fact clearly does not constitute a holding that invention is a question of fact. In dissenting, Mr. Justice Black and Mr. Justice Douglas held it to be a question of law, with Mr. Justice Jackson dissenting on non-invention.

When we enter the Seventh Circuit, we find an unanimity of expression by all judges of the respective panels, holding invention to be a question of law (*Galland-Henning Mfg. Co.* v. *Logemann Bros. Co.* (7 Cir. 1944, Judge Sparks), 142 F. 2d 700, 703; *Loney Co.* v. *Ravenscroft* (7 Cir. 1947, Judge Sparks), 162 F. 2d, 703, 704; *National Slug Rejectors* v. *A. B. T. Mfg. Corp.,* (7 Cir. 1947, Judge Evans), 164 F. 2d, 333, 336: "This century-old question is always perplexing. We cannot avoid or evade it. We must meet it. Patentable invention is a question of law").

The Court of Appeals failed to follow the *Supermarket* case, *supra.*

Notwithstanding the clarion requirements of the *Supermarket* case, *supra,*—that a combination of old elements, after having been held to exist, must be scrutinized to ascertain whether the high constitutional standard of invention has been attained,—a glance at the opinion below satisfies that this was omitted. The Court of Appeals opinion terminates with the citation of cases on alleged combinations. It may, therefore, be fairly said that the decision below is in conflict, in principle, with the *Supermarket* case of this Court. The case at bar and the *Supermarket* case, *supra,* are substantially alike (See *Crest Specialty Co.* v. *Frager* (1951) 341 U. S. 912, 95 L. ed. 1349, reversed without opinion, on the Supermarket case.)

Another conflict, in principle, with the *Supermarket* case, *supra*.

Notwithstanding that this Court has clearly pointed out that a claim like the one in the *Supermarket* case, claiming an entire machine, is an "overclaiming" of the invention if it be a combination, the Court of Appeals failed to apply this long-settled principle of law. The Court of Appeals printed the claim in the case at bar in its opinion (R. p. 271), which shows it to be for the entire apparatus, to wit: "An apparatus of the class described comprising * * *".

Had the Court of Appeals tested this claim on its face, under the requirements of the *Supermarket* case, *supra*, in view of the specification statement that it was an improvement, it must have been brought to the conclusion that again a claim to the entire apparatus had been made, exempting all of its old elements from use by the public. Respondent overclaimed the invention herein, if any. Before 1854, Mr. Justice Story established as elementary in the law of patents, that a claim for an entire apparatus, when the alleged invention is only for an improvement or for a combination of old parts, is void as broader than the invention.[1] Mr. Justice Clifford, in 1868, in dividing inventions into categories, [(1) for the entire machine, (2) for an improvement on that machine, (3) for a new element and new combination having a new element], adds a fourth for a combination of old elements.[2] Respondent

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[1] *Davis* v. *Palmer* and *The Same* v. *M'Cormick*, 1 Robb's Patent Cases, 518, 531 (2 Brockenbrough, 298), Marshall, C. J.; *Dixon* v. *Moyer*, 1 Robb's Patent Cases, 324, 332 (4 Wash. 68), Washington, J.; *Oliver Evans* v. *Eaton*, 1 Robb's Patent Cases, 68, 90 (1 Peters, C. C. 322), Washington, J.; *Stearns* v. *Barrett*, 1 Robb's Patent Cases, 97, 103 (1 Mason, 153), Story, J.; *Evans* v. *Eaton*, 1 Robb's Patent Cases, 193, 203, 204 (3 Wash. 443), Washington, J.; *Evans* v. *Hettich*, 1 Robb's Patent Cases, 166, 184 (3 Wash. 408), Washington, J.; *Evans* v. *Hettich*, 7 Wheat. 453 (U. S.), Story, J.; and *Evans* v. *Eaton*, 7 Wheat. 356 (U. S.), Story, J.; *Woodcock* v. *Parker*, 1 Robb's Patent Cases, 37, 39 (1 Gall. 438), Story, J.

[2] *Seymour* v. *Osborne*, 11 Wall (U. S.) 516, 20 L. ed. 33 (1871).

falls into this last group, which requires a new result never before known to be produced by the joint action of the elements acting in accordance with a new cooperative law. Respondent, having admitted all the elements to be old, and the prior art having shown all the elements of the alleged combination to have been old and used in the same interrelationship, Respondent cannot exempt from the public an entire apparatus.

The important consequence of a holding that an apparatus claim is valid when the apparatus as such is already old, usually requires the accounting to compensate for all the elements listed in the claim when used by a defendant, whereas an improvement claim or a specific combination claim requires compensation only for the narrower contribution actually made.

The *Supermarket* case, *supra,* having in unmistakable terms declared a claim like that here in suit to be void for overclaiming and having stated the requirements of a patentable combination, the necessity for uniformity of decisions throughout the circuits in the interest of the public should have induced the Court of Appeals to follow, and not depart from, the *Supermarket* case, *supra.*

The definition by this Court as to when old elements constitute a valid combination should not be eroded.

Another cleavage in the jurisprudence of the patent law exists as a result of a concept introduced therein by Judge Sanborn of the Eighth Circuit. Contrary to the authoritative holdings of this Court, Judge Sanborn, in *National Hollow B. B. Co.* v. *Interchangeable B. B. Co.* (8 Cir.) 106 F. 907, after citing *Seymour* v. *Osborne,* 11 Wall (U. S.) 516, and *Gould* v. *Rees,* 15 Wall (U. S.) 187, 189, giving the correct rule, added an alternative of considerably less exactitude. This is, as was understood and stated by the Court of Appeals below: "With respect to

the result produced, it is not essential that it be a wholly new result, but it is sufficient if an old result is effected in a more facile, economical, or efficient way." And the Court of Appeals cited cases on page 280 of its opinion in support of that old result formula. Unfortunately, this new concept, erroneous it is submitted, was continued in Judge Sanborn's later cases. It also spread to some other circuits, to the divided-out Tenth Circuit,[1] to the Sixth,[2] Seventh,[3] and now in the Ninth Circuit in the case at bar. While Judge Phillips had, in 1932, followed this old result formula, in the *Independent Oil Company* case, relied on in the opinion below (R. p. 280), nine years later, in *Hutchinson Mfg. Co.* v. *Mayrath,* 192 F. 2d 110, 112, he decided this *Hutchinson* case only on a "new and useful result", omitting reference to the old result formula. At no time, of course, is it the general result, but only the result produced by the joint action of the elements.[4] The test as to a "new result" has been made more severe by the *Supermarket* case, *supra.* The case at bar, because of its reliance on this erroneous formula, and failure to follow the *Supermarket* case, *supra,* should not propagate its bad law any further.

The fact of a combination is shown by its result. The union of elements in a new operation must necessarily produce effects beyond the sum of the effects producible

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[1] *Independent Oil Well Cementing Co.* v. *Halliburton* (10 Cir. 1932), 54 F. 2d, 900, 905.

[2] *N. O. Nelson Mfg. Co.* v. *F. E. Meyers & Bro. Co.* (6 Cir. 1929), 25 F. 2d, 659, c. d. 1932, 287 U. S. 617, 53 S. Ct. 18, 77 L. ed. 536.

[3] *Young Radiator Co.* v. *Modine* (7 Cir. 1932), 55 F. 2d, 545; *Iron Fireman Mfg. Co.* v. *Industrial Engr. Corp.* (7 Cir. 1937), 89 F. 2d, 904; *Safway Scaffold Co.* v. *The Patent Scaffolding Co.* (7 Cir. 1940), 110 F. 2d, 1008.

[4] *Concrete Appliances Co.* v. *Meinken* (6 Cir. 1920, Judge Denison) 262 Fed. 958, 965.

by all the elements in their separate state. Their union must inevitably have brought into action some new or as yet unawakened energy, which constitutes a new and independent means.[1]

A new result is a specified provable thing, a change in kind, enabling a principle of law to be founded thereon, but the alternative, "old result in a more facile, economical, or efficient way", is a change in degree, as variable in each case as the minds of judges vary, and thus not a rule of law.

Conclusion

For the foregoing reasons, this petition for a writ of certiorari should be granted.

May 12, 1952.

Respectfully submitted,

C. P. GOEPEL,
Attorney for Petitioners.

J. E. TRABUCCO,
Counsel.

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[1] Robinson on Patents, Vol. 1, Sec. 156, p. 225.

Section 4888

Sec. 4888 (U. S. C., Title 35, Sec. 33). Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefore in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art of science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery • • •.

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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1951

No. 774

OXNARD CANNERS, INC., a corporation, and JAMES L. SMITH,
Petitioners,

vs.

THOMAS H. BRADLEY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

SUMMARY STATEMENT.

The decision of the Court of Appeals for the Ninth Circuit sought to be reviewed on writ of certiorari was rendered in a patent infringement action. The action was ordinary in all respects in that the issues joined were the usual ones of invalidity of the patent on the grounds

that it lacked invention and was anticipated by prior art, and that the defendant's machine did not infringe the same. The action was one at law and tried before a jury. There were no exceptions taken to the Court's instructions to the jury by either side, and the jury rendered a verdict in favor of the plaintiff, finding the patent valid and infringed and awarding the plaintiff a reasonable royalty of Two Hundred Seventy Dollars and Fifty-nine Cents ($270.59) against one defendant and nominal damages of Ten Dollars ($10.00) against the second defendant.

Upon the filing of the verdict of the jury, defendant presented a motion (R. 19) for judgment notwithstanding the verdict or for a new trial, which was reviewed and denied by the District Court (R. 254). Thereupon in due course an appeal was filed to the Court of Appeals for the Ninth Circuit, alleging (in substance) as error that the patent was invalid as a matter of law in that it disclosed no patentable invention, and that the verdict of validity was contrary to the evidence. Also urged as error was that there was no infringement as a matter of law, and that the verdict of infringement was contrary to the evidence (R. 259).

The Court of Appeals for the Ninth Circuit, after a review of the entire record, affirmed the judgment and from its opinion (R. 270-280) it is clear that the Court of Appeals compared the patented device with the prior art relied upon in defense, and was convinced as a matter of fact and law that the patent disclosed a real, substantial and patentable invention.

It is also clear from the opinion that the Court of Appeals measured the patented machine against the accused machine and was convinced that infringement was clearly proven in that the patented and accused machines were substantially the same in construction, mode of operation, and produced the same result by substantially the same means and mode of operation.

ARGUMENT.

THERE IS NO SPECIAL OR IMPORTANT REASON FOR GRANTING THE PETITION FOR WRIT OF CERTIORARI.

We appreciate that a review on writ of certiorari rests in the sound judicial discretion of this Court, but this Court has always held that such a writ will be granted only where there are special and important reasons therefor. We urge that no such reasons are here presented.

(1) In the instant matter the decision of the Court of Appeals sought to be reviewed is not in conflict with the decisions of another Court of Appeals on the same matter.

(2) Petitioners state as a reason for granting the writ that there is probable absence of conflict in other circuits. This is not based on the record and is not true in fact because the petition itself on page 9 states that only a limited number of the machines were used "only in the Ninth Circuit and in foreign countries". There is a complete absence of any testimony or other evidence showing this to be the fact. These machines are for use in eviscerating Monterey sardines (about herring size), which are relatively large fish, and the same machine is

used for eviscerating mackerel and the large type of anchovies, as well as herring. These fish, as the Court may take judicial notice of, abound in the coastal waters of many countries, including both coasts of the United States. Consequently, there is no basis in the record or in fact for petitioners' statement in the petition that there is "a probable absence of conflict in other circuits". The fact that the machines are relatively new and are built locally in California by the petitioners would be one reason that they were not in use (if such is the case) along the Atlantic coast as well as along the Pacific coast.

(3) As a second reason for granting the writ, petitioners urge that the Court departed from the usual course or practice in patent cases. We urge that there is no basis for such contention. The District Court, in considering the motion for a directed verdict as well as the motion for a judgment notwithstanding the verdict and for a new trial, considered the question of validity of the patent and the question of infringement and denied such motions. This is clear from the District Judge's statement, "it did appear that there was a contribution by the plaintiff from the claims of his patent of a combination nature that did give a plausible ground for the issuance of the patent—and I think that could be seen by the jury just as well as it could be by the Court—".

As to the question of infringement raised by such motions, the District Court held, "As to the question of infringement, I am satisfied that there isn't any question about the correctness of the jury's verdict."

The Court of Appeals, in reviewing the question of invalidity raised by the appeal, diligently measured the patented machine as against the prior art, as is evident from the following in its opinion (R. 270-280), and concluded that it was a patentable invention:

> "We therefore look at the evidence on the issues of validity and infringement. Uncontradicted testimony of appellee Bradley shows that prior to 1944, (the year that Bradley's machine was first installed in a plant) eviscerating devices then used did not meet state requirements. Hand inspection of each fish was then necessary. This inspection precluded the use of any mechanical packing machine. When, in 1944, appellee produced a machine embodying his invention and placed the same in operation in a Monterey cannery, it not only removed at least 95% of the fish viscera, but did so at the rate of 180 fish per minute, thus enabling the fish to be mechanically packed into cans. That the production of such a machine as appellee's was a boon to the industry is clearly indicated by the testimony of Joseph Benossi, the superintendent of a fish packing company not involved in this litigation.
>
> * * * * *
>
> It is also undisputed that without such an efficient eviscerating machine mechanical packing machines are valueless and of no practical use in the industry."

The Court of Appeals also concluded that the patented machine was a new combination of elements having a new mode of operation, and which produced a new or improved result, and properly applied the law to these findings as follows:

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"Aside from that, it is well settled that a combination of old elements which form a machine having a new modus operandi and which produces a new or improved result is patentable. R.S. §4886, 35 U.S.C. §31; Cantrell v. Wallick, 117 U. S. 689, 1886. 'With respect to the result produced, it is not essential that it be a wholly new result, but it is sufficient if an old result is effected in a more facile, economical, or efficient way.' Independent Oil Well Cementing Co. v. Halliburton, 54 F.2d 900, 905, 10-Cir., 1932, cert. denied, 286 U.S. 544, and cases cited therein. See also Levin v. Coe, 132 F.2d 589, 596, C.A.D.C., 1942; Application of Barrett, 182 F.2d 626, 630, C.C. P.A., 1950."

Thus, it is evident that contrary to the petitioners' statement there was no departure from the usual practice in patent cases or in the standards of law determining invention in the decision by the Court of Appeals for the Ninth Circuit in the instant case.

(4) The Court of Appeals' decision is not in conflict with the decisions of this Court. There is no conflict between the decision of the Court of Appeals in the instant case and the applicable decisions of this Court. In the case of *Faulkner v. Gibbs* (9 Cir. 1948), 170 F. 2d 30, 34, this Court held that under certain circumstances the question of validity (when applied to the matter of invention) and the question of infringement were questions of fact. This case is not in conflict with the case of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 95 L.Ed. 162, wherein this Court decided that the Courts should in proper cases consider

the question of patentable invention as a matter of law to make certain that the invention met the constitutional standards of patentability. This was done by the District Court in denying the motion for directed verdict and also by the Court of Appeals for the Ninth Circuit, as is evident from its opinion, in concluding patentability from the substantiated facts that the patented machine accomplished something entirely new in the industry and was a boon to the industry, and that it was a new combination of elements producing a new or improved result, as previously set forth. That Court also concluded that the patented machine was patentably novel from its review of the evidence on the factual question as to whether or not the patented and prior machines were similarly constructed and had a similar mode of operation, and produced similar results. On this question the Court of Appeals opined:

> "* * * Both appellee Bradley and witness Benossi testified that the operation of appellee's device was not, in any fashion, akin to that shown in prior art devices referred to as Gray, Kurzbin, and Abbott. Nor was the construction anywhere comparable. As to a McGrew patent, contended by appellant to have anticipated appellee's invention, the only evidence on the subject was elicited from Smith. And such evidence, from this appellant himself, establishes that the McGrew machine is totally unlike the Bradley (or Smith) machine in mode of operation, construction, and result."

(5) There is no question but that the judgment which was sustained by the Court of Appeals was supported by

substantial evidence on the questions of invention, validity and infringement. The Court of Appeals, after reviewing the evidence (as is evident from its opinion (R. 270-280), found that the judgment as to these three issues was not only supported by substantial evidence, but in some instances the only evidence.

CONCLUSION.

We submit—

(1) That there is no special or important reason for granting the petition for writ of certiorari.

(2) That there was no error in the decision of the Court of Appeals for the Ninth Circuit sought to be reviewed.

(3) That the law applied by the Court of Appeals for the Ninth Circuit in reaching its decision is not in conflict with any applicable decision of this Court or any other Court of Appeals.

Therefore, we respectfully submit that the petition for writ of certiorari should be denied.

Dated, San Francisco, California,
May 23, 1952.

Respectfully submitted,
OSCAR A. MELLIN,
JACK E. HURSH,
Attorneys for Respondent.

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IN THE

Supreme Court of the United States

October Term, 1951
No. 774

OXNARD CANNERS, INC., a corporation, and JAMES L. SMITH,

Petitioners,

against

THOMAS W. BRADLEY,

Respondent.

PETITIONERS' REPLY BRIEF

C. P. GOEPEL,
Attorney for Petitioner.

J. E. TRABUCCO,
Counsel.

SUPREME PRINTING CO., INC., 41 MURRAY STREET, N. Y., BARCLAY 7-0349
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PETITIONERS' REPLY BRIEF

I

Respondent does not question the correctness of the legal principles stated in Petitioners' Brief, nor the statements of fact, save one minor fact to be hereinafter referred to. Respondent urges that no special and important reasons appear for the granting of the writ. The Petition herein presents some of the most important points in the law of patents, to wit:—

(a) Is the determination of invention a matter of law?— as to which the First Circuit is awaiting a decision of this Court (Petition, pp. 15, 16, Questions No. 1 and No. 4), and, in the absence of which, the first Circuit stated it was unable to aid in obtaining a uniform application of the patent law.

(b) Is the determination of a true combination a matter of law or a matter of fact? (Petition, pp. 18-29, Question No. 2).

(c) Is it essential to hold presence of invention even if a true combination has been found to exist? (Petition, p. 16, Question No. 3).

(d) Is it good law to consider a patent claim for an entire machine to be a combination claim, instead of voiding such an entirety claim for overclaiming (Petition, p. 17, Question No. 5).

These questions go to the life of our practical patent law and enter into the entire substance of our industrial life.

The minor statement of fact questioned by Respondent (Resp. Br., pp. 3 and 4) is that the machines were "used only in the Ninth Circuit and foreign countries" (Petition, p. 9). In the record appears (testimony of James L. Smith), at page 208: "Q. Well, your device has met with commercial success? A. Yes, we have them all over Monterey and down south and in foreign countries." (Elsewhere, San Diego, Cal. is referred to, R. p. 113, which is "down South" from San Francisco, Cal.)

As there is no evidence showing use anywhere else, it was entirely correct to say that such machines were "used only in the Ninth Circuit and in foreign countries."

The remainder of Respondent's brief endeavors to support the correctness of the judgment below by general conclusions. We are not permitted at this time to enter into the merits of the validity issue, except to say that Respondent seems to construe *Cantrell* v. *Wallick*, 117 U. S. 689, 29 L. ed. 1017 (1886), as the Court of Appeals may have done, to wit.:—that "a new or improved result is patentable" (R., pp. 279, 280), to mean that an "improved result" is an old result improved. From the context of the opinion of *Cantrell* v. *Wallick* which speaks only of a new result, a "new result" and "an improved result" in the part quoted from the opinion below can only be identical or synonymous.

The statement (Res. Br., p. 4) that the machines are built locally in California "by the Petitioners" emphasizes the paralysis in the industry if the judgment be allowed to remain permanent, and fully supports Petitioners' Reason (Petition, p. 9).

II

Respondent refrains from even mentioning in his Brief that the accused machine, held by the courts below to infringe the Bradley patent, was indisputably constructed in accordance with the patent issued to Lockwood and Petitioner Smith and, of course, makes no comment on the legal implications arising therefrom and from the fact that both applications were co-pending in the Patent Office for over three years, and on the absence of legally sufficient evidence in the record to overcome the presumption of non-identity of the respective inventions, or to the evidence contrary to infringement (R. p. 228).

That the Smith-Lockwood commercially successful machine is radically different from the Bradley machine, of which some were used by one concern (R. pp. 67, 68), is apparent from a comparison of the two structures and the descriptions thereof in the respective patents. The essential point of difference is the structure employed at the respective eviscerating suction points. The Bradley machine employs a rotatable flat disk, positioned and rotating in a vertical plane, in which disk are holes, to the upper one of which a decapitated fish is moved by a horizontal conveyor, where with reference to the said hole, suction on the viscera of the fish, as in the eclipse of the moon, waxing, full, and waning, takes place (R. pp. 220, 225). The fish is cut short to prevent being slidingly carried along by this arcuately rotating hole or to enter it except by applied suction waxing, full, and waning. This cannot clean all fish (R. p. 213). The Smith-Lockwood structure employs a rotating cylinder positioned with holes rotating horizontally in the plane of

the horizontally moving conveyor; and the point of contact of that rotating cylinder with the horizontally moving decapitated fish is and can only be tangential (R. p. 224), giving a complete registration of the hole with the viscera, the fish viscera entering into that hole, the fish being cut long for that purpose (R. pp. 218, 219).

The principles of physics and mechanics employed in the respective machines are obviously different as are the operation and practical consequences thereof—witness the necessity of a clamp on the Bradley machine to hold down the fish upon contact with the rotating disk, and no such clamp is needed or used on the Smith-Lockwood machine. Since in the latter machine the contact of the decapitated fish is tangential to the revolving cylinder, the point of contact is single and complete, affording a complete vacuum for the eviscerating process, without marring or messing up the fish. As the disk type of Respondent was 25% less efficient than the cylinder type of Petitioner (R. p. 213), the industry accepted the cylinder for its efficiency and rejected the disk for the opposite reason. The viscera is spaced a quarter of an inch back from the disk (R. p. 73); but on the cylinder, the viscera protrudes an inch and a half beyond the conveyor and thus into the hole of the cylinder when the hole is tangential to the viscera (R. p. 219). And the Patent Office likewise recognized this vital feature in granting the Smith-Lockwood patent application, notwithstanding its copendency with the Bradley application for over three years.

The evidence most favorable to Respondent, appearing anywhere in the Record, that the Smith-Lockwood machine infringed the Bradley patent is quoted in the opinion of the Court of Appeals (R. pp. 274-275); but such evidence, it is submitted, is legally insufficient. *McRoskey* v. *Braun Mattress Co.* (9 Cir. 1939), 107 F. 2d 143, 146, *Metropolitan R. R. Co.* v. *Moore* (1887), 121 U. S. 558, 30 L. ed. 1022, 1025.

Absent any conflict of crucial legally sufficient evidence of infringement to overcome the said presumption of the non-infringement of the Bradley patent by the Smith-Lockwood patent structure, the question of infringement is still solely one of law, reviewable by this Court (*Sanitary Refrigerator Co.* v. *Winters* (1929), 280 U. S. 30, 36, 74 L. ed. 147, 152).

June 2, 1952.

Respectfully submitted,

C. P. GOEPEL,
Attorney for Petitioner.

J. E. TRABUCCO,
Counsel.